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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,575	06/16/2006	Magdalena Rotthaeuser	740116-621	8008
25570	7590	10/10/2007	EXAMINER	
ROBERTS, MLOTKOWSKI & HOBBS			WRIGHT, GIOVANNA C	
P. O. BOX 10064			ART UNIT	PAPER NUMBER
MCLEAN, VA 22102-8064			3672	
NOTIFICATION DATE		DELIVERY MODE		
10/10/2007		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Dbeltran@rmhlaw.com  
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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/596,575	ROTTAEUSER, MAGDALENA	
	<b>Examiner</b> Giovanna M. Collins	<b>Art Unit</b> 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 16 June 2006.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-17 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 16 June 2006 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 6/16/06.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

1. The disclosure is objected to because of the following informalities: The section headings have been omitted.

Additionally the applicant makes reference to claims 1 and 16 in the background information. This is improper since it can be appreciated that scope and or claim numbering may change during prosecution.

Appropriate correction is required.

The specification (including the abstract and claims), and any amendments for applications, except as provided for in 37 CFR 1.821 through 1.825, must have text written plainly and legibly either by a typewriter or machine printer in a nonscript type font (e.g., Arial, Times Roman, or Courier, preferably a font size of 12) lettering style having capital letters which should be at least 0.3175 cm. (0.125 inch) high, but may be no smaller than 0.21 cm. (0.08 inch) high (e.g., a font size of 6) in portrait orientation and presented in a form having sufficient clarity and contrast between the paper and the writing thereon to permit the direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by use of digital imaging and optical character recognition; and only a single column of text. See 37 CFR 1.52(a) and (b).

The application papers are objected to because the font of the specification and the claims is too small.

A legible substitute specification in compliance with 37 CFR 1.52(a) and (b) and 1.125 is required.

The applicant makes reference to claims 1 and 16 in the background information. This is improper since it can be appreciated that scope and or claim numbering may change during prosecution.

***Claim Objections***

2. Claims 3-11,14-15 are objected to because of the following informalities:

Regarding claims 3-4,9,11, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

Regarding claims 4 and 7, the phrase "if necessary" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

Claim 5 recites the limitation "the measured value pickups" in line 3. There is insufficient antecedent basis for this limitation in the claim, as this limitation has not been previously recited.

Claims 6-7 recite the limitation "the medium under investigation" in lines3. There is insufficient antecedent basis for this limitation in the claims, as this limitation has not been previously recited.

Claim 8 recites the limitation "the pump" in line 3. There is insufficient antecedent basis for this limitation in the claim, as this limitation has not been previously recited.

Claims 10-11 recite the limitation "the packer" in lines 2 and 3, respectively. There is insufficient antecedent basis for this limitation in the claims, as this limitation has not been previously recited.

Claim 12 recites the limitation "the functional units" in lines 3. There is insufficient antecedent basis for this limitation in the claim, as this limitation has not been previously recited.

Claim 14 recites the limitation "the packer" in line 3. There is insufficient antecedent basis for this limitation in the claim, as this limitation has not been previously recited.

Regarding claims 15, the phrase "preferably" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

Appropriate correction is required.

### *Drawings*

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the non return valve must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 41 and 56. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-9-12-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Berger 5803186.

Berger discloses a measuring device (16) for connection to a drill column for deep wells, having an electrically operated measuring unit (see fig. 3, at 16) for measuring relevant data, the measuring device being designed for supplying electrical energy via the drill column) and for data transfer to the surface likewise via the drill column, characterized in that an outer housing of the measuring device having at least one inflow opening (see fig. 53, at 51) and at least one outflow opening (36) is provided, and in that the housing (41) has screw" connections at its two ends for connection to the drill column and/or the bit device (the device can be connected to threaded drilling string which would require it to have threaded connection, col. 2, lines 50-51).

Referring to claims 2 and 16, Berger discloses a surface evaluation device ( see fig. 8 at 100) electrically coupled to the measuring device.

Referring to claim 3, Berger discloses a transformer ( at 104).

Referring to claim 4, Berger discloses a plurality of measuring instruments (see fig. 8, at 446).

Referring to claims 5, Berger discloses the measured pickups are directed in a flow path within the housing ( signals from sensors directed toward control unit 106 which is in the housing, see fig. 8).

Referring to claim 6 Berger disclose an electrically operated pump ( 53).

Referring to claim 7, Berger discloses electrically operated valve units ( see fig. 8).

Referring to claim 8, Berger discloses a valve upstream of the pump (piston 45 functions as a valve).

Referring to claim 9, Berger discloses an electrically operated packer (in that the control valve 30 that inflates packers 24 and 26 is electrically operated).

Referring to claim 12, Berger disclosed an electrically operated control unit ( 102).

Referring to claims 13, Berger discloses an energy store ( 106).

Referring to claim 14, Berger disclosed an inflow opening (51) beneath a packer and an outflow opening ( at 36) above the packer.

Referring to claim 15, Berger discloses a through opening ( see fig. 3, at 84) in the housing that communicates with the drill column and a non return valve ( 82) closing the through opening.

Referring to claim 17 Berger disclose the unit is connected to a bit ( see fig. 1, at 8).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berger '186 in view of Eslinger 5280824.

Berger discloses an inflatable packer ( 24) but does not disclose overlapping segments. Eslinger teaches ( see fig. 2) an inflatable packer with overlapping segments to help reinforce the inflatable bladder ( see col. 1, lines 20-23). As it would be advantageous to help reinforce the inflatable bladder, it would be obvious to one of ordinary skill in the art to modify the device disclosed by Berger to have a packer with overlapping segments in view of the teachings of Eslinger .

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berger '186 in view of Niedermayr 20040040746.

Berger discloses that drilling fluid is pumped down the strings, which will lubricate the packer. Berger does not disclose the means to pump the drilling mud is electric. Niedermayr teaches electric mud transfer pumps are well known in the art ( paragraph 0043). As one of ordinary skill in the art would be familiar with electrically operated mud transfer pumps, it would be obvious to one of ordinary skill in the art at the time of the

invention to modify the device disclosed by Berger to have an electrical operated lubricant supply device in view of the teachings of Niedermayr.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Giovanna M. Collins whose telephone number is 571-272-7027. The examiner can normally be reached on 6:30-3 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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